PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of	Docket No: A8506 IBM Docket No.: SVL920010059US1
William R. BELKNAP, et al.	
Appln. No.: 09/986,248	Group Art Unit: 2173
Confirmation No.: 5036	Examiner: Dennis G. BONSHOCK
Filed: November 8, 2001	

For: SYSTEM AND METHOD FOR PACKING OF SMALL OBJECTS FOR EFFICIENT DELIVERY OVER NETWORKS

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant respectfully submits this Reply Brief in response to the Examiner's Answer dated October 6, 2008. Entry of this Reply Brief is respectfully requested.

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STATUS OF CLAIMS

Claims 1-3, 7-10, 13-15, 19-23, 25-29, 31, 32, and 34-36 are all the claims pending in the application. Claims 1-3, 7-10, 13-15, 19-23, 25-29, 31, 32, and 34-36 have been rejected, and are the subject of this appeal. Claims 4-6, 11, 12, 16-18, 24, 30, and 33 have been canceled without prejudice or disclaimer.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following is a concise statement of each ground of rejection presented for review:

1. Whether claims 1-3, 7-10, 13-15, 19-23, 25-29, and 34-36 are properly rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,282,711 to Halpern *et al.* ("Halpern") in view of the Appellants' admitted prior art ("AAPA") and U.S. Patent No. 7,099,950 to Jones *et al.* ("Jones").

2. Whether claims 31 and 32 are rejected properly under 35 U.S.C. § 103(a) as being unpatentable over Halpern in view of U.S. Patent No. 6,075,943 to Feinman, and further in view of the AAPA.

ARGUMENT

Appellants submit the following in response to the Examiner's Answer and specifically to the Examiner's comments that begin on page 30 of the Examiner's Answer.

In relation to the Examiner's initial referral to the prior Decision on Appeal dated February 22, 2007, Appellants do not acquiesce to the Examiner's statements that "the bulk of what the Applicant's specification claims is novel subject matter was claimed prior to this Board Decision where the Examiner rejection was affirmed in said proceeding. The amendments since the Board Decision seem to only describe the current state of the art for transmission of data between a server and a client" (Examiner's Answer, page 30, first paragraph).

Appellants submit that the amendments to the claims that were made in the Amendments filed April 23, 2007 and October 16, 2007 do more than describe the current state of the art for transmission of data between a server and a client. These amendments claim additional novel subject matter that was not claimed prior to the last Board Decision. For instance, in the background section of the Appellants' Specification, the disadvantages of setting up and tearing down multiple communication sessions between a server and a client are disclosed (e.g., this results in a high degree of overhead processing, Specification, at pg 3, line 16 to pg 4, line 18). In view of this problem in the related art, the Appellants' Specification discloses an embodiment of the invention in which the data transmission between a server and a client is carried out in a single session. In the October 16th Amendment, claim 1 was amended to claim that the searching, receiving search results, generating, packing, and receiving the response message are all carried out within a session opened with the at least one server in view of this embodiment.

The amendment caused the Examiner to add another reference (U.S. Patent No. 7,099,950 to Jones *et al.*) to the previous combination of U.S. Patent No. 6,283,711 to Halpern *et al.* and the Applicants' admitted prior art in the obviousness rejection and further alter his reasoning to combine the references. Therefore, contrary to the Examiner's assertions, the Board is presented with an altogether new set of issues based on the new combination of references and the Examiner's given reasoning for combining them.

Claim Rejections - 35 U.S.C. § 103

Claims 1-3, 6-10, 13-15, 18-23, 25-29, and 34-36

Claims 1-3, 6-10, 13-15, 18-23, 25-29, and 34-36 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,282,711 to Halpern *et al.* ("Halpern") in view of the Appellants' admitted prior art ("AAPA") and U.S. Patent No. 7,099,950 to Jones *et al.* ("Jones"). For *at least* the following reasons, Appellants respectfully traverse the rejection.

In response to the arguments in the Appeal Brief filed July 2, 2008 (hereinafter, "Appeal Brief") that the given reason for motivation to combine the teachings of Jones with Halpern and the AAPA is based on hindsight, the Examiner now asserts that "it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin,* 443 F.2d 1392, 170 USPQ 209 (CCPA 1971)" (Examiner's Answer, page 33, second paragraph, emphasis added). As noted in the emphasized portion however, *In re*

McLaughlin dictates that the Examiner's judgment may not include knowledge gleaned only from the Applicants' disclosure. As shown in detail on pages 19-24 of the Appeal Brief, the Examiner's motivation of performing the steps set forth in claim 1 within a session is only found in the Appellants disclosure.

Further, in support of the combination of Halpern and the AAPA with Jones, the Examiner cites col. 1, lines 38-41, col. 2, lines 48-63, and col. 5, lines 26-30 of Jones (Examiner's Answer, page 34, lines 10-16). These portions of Jones relate to legacy debugging tools in which ad hoc syntaxes that specify request and replies are disclosed. To the extent that these portions relate to a client-server relationship, they do not teach or suggest the operations performed in claim 1 between the opening and ending of the session, e.g., searching for an information element, generating requests for at least two objects which were included in the search results for the information element, and thereafter (i.e., after ending the session) automatically unpacking the at least two objects contained in a response message from the server for displaying the objects on the web page, and for which features Halpern and the AAPA are relied on. Therefore, there is no reason a skilled artisan would draw from the teachings of Jones and incorporate them with the teachings of Halpern and the AAPA because Jones teachings do not at all relate to the type of data exchange taught in Halpern and the AAPA.

The Examiner also contends that it would be beneficial and obvious "to use the session in the client server interaction of Halpern and AAPA as a session defines distinct start and end points for a communication, not requiring a server / client to continue awaiting a response /

acknowledgement while the other device has concluded communication" (Examiner's Answer, page 34, lines 16-19). Appellants disagree.

First, neither Halpern nor the AAPA teach that a requesting server or client continues to await a response or an acknowledgment while the other (requested to) device has concluded communication, thus rendering the Examiner's reasoning moot. The Examiner has not shown where Halpern and the AAPA are deficient in this respect. Accordingly, the Examiner is forced to rely on impermissible hindsight to draw from the teachings of Jones for the "session" in claim 1 and alleging this would be obvious, since the only disclosure of transmitting packed requests and receiving objected packed into a responses message (allegedly taught by Halpern and/or AAPA) within a single session (allegedly taught by Jones) is in the Applicants' disclosure. Therefore, the Examiner has still not established a *prima facie* case of obviousness.

On page 35, in the first paragraph, the Examiner contends that "Jones is not being relied upon for the step carried out in claim on only the initiation of a session, request for data, response of data, and termination of session (see column 2, lines 48-63). The Applicant appears to misunderstand the Examiner assertions that "Halpern and AAPA do not disclose or suggest carrying out the above-noted features within a session", as Halpern and AAPA do teach the above-noted features, just without the features being implemented in a session, further showing that it would be obvious to perform the network communication in a network established session, as is done in Jones". Appellants submit that the Examiner is impermissibly picking and choosing particular operations of the claim to be carried out within Jones' session, and other operations to be carried out outside Jones' session, in an effort to render the claim unpatentable

but without any rationale to do so except the requirements of the claim itself. That is, even assuming *arguendo* that the combination of the references separately teaches each of the claim features, none of the cited references suggest carrying out some features within the session and other features outside the session. For instance, without recourse to Appellants' disclosure, the Examiner cannot come to the conclusion that the searching, receiving search results, generating, packing, and receiving a response message are carried out within the session (as required by claim 1), and the unpacking and displaying the unpacked objects contained in the response message are carried out after the session has ended. There is no basis on which the Examiner can come to such a conclusion absent the Appellants' disclosure.

Next, the Examiner contends that Jones teaches terminating "the session when transmission is complete (see column 2, lines 48-63), so when all the data is received the session is termination [*sic*], where there is no need to keep the session open while the data is unpacked and displayed. Halpern teaches downloading a package of all the data requested and when the entire package is downloaded (end of download session) the package is unpacked, installed, and displayed (see column 3, line 61 through column 4, line 19)" (Examiner's Answer, page 35, last paragraph). Appellants respectfully disagree. In the responses from the server 210 to the client 205 in Jones, the actions on the requested data are taken during, not after, the session. For example, as noted previously, any operation on the requested objects, such as deletion thereof, is carried out within the session (see FIG. 3 - '<delete>', and FIG. 4 - '<delete-response>'). Therefore, if Jones' session was implemented in the purported combined system of Halpern and

the AAPA, Jones still would not teach or suggest terminating the session prior to unpacking the requested objects for displaying on a webpage on a client side as set forth in claim 1.

With respect to the previously submitted arguments related to claims 8, 20, and 28 on pages 25 and 26 of the Appeal Brief, the Examiner again cites col. 11, lines 40-52 of Jones which allegedly teach that "responses by the server are returned in an order different from the order of request by the client, with response content being transmitted with ID numbers, and a final piece tag to show the end of a transmission session and also aids in reordering content transmitted out of order. Where as stated above Halpern is relied upon for the idea of transmitting data of a session in packets that are unpacked upon arrival at the client" (Examiner's Answer, page 36, second full paragraph).

Appellants submit that the Examiner is taking the "final piece" in Jones out of context. Jones final piece is a piece of a single response (e.g., an object) that is broken down into many pieces and subsequently rebuilt on a client side (Jones, col. 11, lines 44-52). That is, the final piece is not a response among multiple responses, but rather, a part of a single response. Using serial numbers assigned to the pieces of a response, the response is recreated in Jones. On the other hand, claims 8, 20, and 28 recite, in some variation, that the first order is different from the order in which the plurality of the objects are automatically **packed**. Although Jones teaches that the many pieces of a single response can be transmitted out of order and such pieces can be reconstructed on the client side based on information in the pieces, it does not teach including in a response message an indicator of an order in which a plurality of responses (i.e., not pieces of a single response) are to be displayed that is different from the order in which the plurality of the

objects are generated on the server side (since the Examiner is relying on Halpern for the packing) as required by claims 8, 20, and 28. Accordingly, the Examiner still fails to establish a *prima facie* case of obviousness.

Claims 31 and 32

Claims 31 and 32 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Halpern in view of U.S. Patent No. 6,075,943 to Feinman, and further in view of the AAPA. For *at least* the following reasons, Appellants respectfully traverse the rejection.

The Examiner contends with respect to claim 31 that "Halpern teaches a system for the transfer of multiple objects between a server and a client and outputting a plurality of unpacked objects (see column 6, lines 1-67), and is further supplemented by Feinman who teaches a system for packaging up one or more applications for transfer between a server and a client (see column 2, lines 34-45) similar to that of Halpern, but further teaches, in column 3, line 43 through column 4, line 12, the outputting of applications providing an indication of a certain order, as indicated by the server" (Examiner's Answer, page 38, last paragraph, emphasis added). Appellants respectfully disagree.

For instance, Feinman's system is not similar to Halpern's because in Feinman, the server is not acting in response to a request from a client like in Halpern. Rather, Feinman is directed to remote installs from a sever onto a client in an unattended mode where there are no requests from the client (see Feinman, col. 1, lines 43-59, and Appeal Brief, page 28, second full paragraph).

Moreover, the Examiner again asserts that "[t]he compression and decompression of the files done by compression and decompression programs (column 3, lines 7-43), where the automatic installations system builds a command for the remote submission, the command (indication) containing the name of the appropriate decompression program to run (which specifies the order to present data) (see column 5, lines 49-55)..." (Examiner's Answer, page 38-40, emphasis added). That is, the Examiner still relies on the command of Feinman for allegedly teaching the claimed indicator of a predetermined order in which the packed objects are to be presented. However, as noted previously, the compressed file sent to the client in Feinman does not comprise the sequential file 100 which is used to identify a remote client's delivery points and delivery timings. The installations are carried out remotely by the server, and the order of the installation is not transmitted to the client.

Specifically, as submitted on page 20 of the October 16th Amendment, Feinman discloses that the automatic installation system runs on the source computer (col. 2, lines 47-48). As shown in FIG. 7, the sequential file contains a DELIVERY POINT 118 field. This field contains the name of the remote delivery point, i.e., "the remote computer onto which the compressed file will be transferred and the installation performed" (*see* Feinman, FIG. 7). Moreover, the sequential file 100 contains a TARGET INFORMATION 120 field, which includes a login id and login password for logging into the delivery point (i.e., the target remote computer). Since the automatic installation system resides on the source computer, it follows that the sequential file 100 also resides on the source computer, because the automatic installation system uses the information in the sequential file 100 to determine a target remote computer to which the

compressed file will be delivered, and also uses the login information included in the sequential file 100 to login to the target remote computer. Therefore, Feinman does not disclose or suggest that the compressed file sent to the client comprises the sequential file 100.

On page 40 of the Examiner's Answer, the Examiner for the first time appears to be suggesting that Feinman's command run on a client machine which allegedly indicates the name of the appropriate decompression program to run teaches the claimed indicator specifying the order to present data (Examiner's Answer, page 40, second paragraph). Appellants disagree. For instance, the command and/or the decompression program at most teach an indicator which indicates an order in which the compressed programs are to be decompressed, not presented. There is no presentation of the programs in Feinman, only decompression. Accordingly, Feinman's command and the decompression program cannot teach or suggest the claimed indicator of a predetermined order in which the packed objects are to be presented.

Lastly, the Examiner maintains that the combination of Halpern and Feinman teaches a requested plurality of objects that are packed into the packed object prior to receiving the request for the plurality of objects in response to the previously submitted arguments in the Appeal Brief on pages 28 and 29. Specifically, the Examiner asserts that "[i]t is admitted by the Applicant that Feinman teaches "in step 12 of FIG. la"..."the automated installation system packages the one or more applications into a compressed file. This step carried out absent any request for the compressed file form the destined remote client". The Examiner respectfully contends that Halpern is relied upon for the teaching of requesting data transmission, and is supplemented by the above teaching of Feinman showing packaging of applications prior to any user request. So

we have Feinman's system which prepackages application packets and Halpern's system that requests packed applications, the combination would be obvious" (Examiner's Answer, page 41, first full paragraph). Appellants disagree.

As noted above and in the Appeal Brief, there is no request in Feinman. Therefore, Feinman cannot possibly teach the claimed limitation that the plurality of objects requested for by the client are packed into the packed object prior to receiving the request for the plurality of objects. Halpern, as the Examiner acknowledges, teaches packaging of requested objects after receiving a request for the objects. The files that are packaged in step 12 of FIG. 1a of Feinman are not requested for, but rather, remotely installed by Feinman's server onto a client absent any request. As such, the combination of the references still does not teach or suggest the claimed feature at issue. Moreover, a skilled artisan would have no reason to draw from the teachings of Feinman and incorporate them into Halpern's system since Halpern is directed to a request-driven system, whereas Feinman is directed to a system that is implemented in an unattended mode (i.e., without requests from a client).

Therefore, Appellants respectfully submit that Feinman alone, or in combination with Halpern and the AAPA, does not disclose or suggest the noted features of claim 31.

CONCLUSION

For the above reasons as well as the reasons set forth in Appeal Brief, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal.

An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,

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